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07-12-04

1636

*[Signature]*

PTO/SB/21 (05-03)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	10/055,794
		Filing Date	January 17, 2002
		First Named Inventor	FARMER, ANDREW ALAN
		Group Art Unit	1636
		Examiner Name	MARVICH, MARIA B.
Total Number of Pages in This Submission	19	Attorney Docket Number	CLON-069

### ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	1) Communication in response to Notice of Non-Responsive Amendment (2 pgs.)
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	2) Petition to Withdraw Holding of Abandonment (2 pgs.)
<input type="checkbox"/> Certified Copy of Priority Documents	<input type="checkbox"/> CD, Number of CD(s)	3) Copy of Amendment as filed on September 19, 2002 (13 pgs.)
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Remarks	4) Statement Attesting to Timely Mailing of Correspondence to USPTO (1 pg.)
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		5) Return Postcard

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Signing Attorney/Agent (Reg. No.)	BRET E. FIELD, 37,620 BOZICEVIC, FIELD & FRANCIS LLP
Signature	
Date	July 8, 2004

### EXPRESS MAIL LABEL NO. EV333997202US

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



EXPRESS MAIL No.: EV333997202US

COMMUNICATION		Attorney Docket	CLON-069
Address to:		First Named Inventor	Farmer, Andrew Alan
Commissioner for Patents		Application Number	10/055,794
P.O. Box 1450		Filing Date	01-17-2002
Alexandria, VA 22313-1450		Art Unit	1636
		Examiner	Maria Marvich
		Title:	"SEQUENCE SPECIFIC RECOMBINASE-BASED METHODS FOR PRODUCING INTRON CONTAINING VECTORS AND COMPOSITIONS FOR USE IN PRACTICING THE SAME"

Sir:

This communication is responsive to the Notice of Non-Responsive Amendment dated June 9, 2004, for the above-captioned application, for which a one-month period of response was given making this response due on or before July 9, 2004.

The Examiner notes in the Communication that the original reply, which was not received by the Office, must be accompanied by the USPTO filing receipt, such as a stamped postcard, from the USPTO indicating the date the Office had received the response. However, the Applicants are unable to furnish the Office with a postcard because a stamped postcard was never returned to the Applicants from the Office. Accordingly, in lieu of the postcard, enclosed please find a statement under 37 C.F.R. § 1.8(b) by the undersigned attesting on a personal knowledge basis to the timely mailing of the response, which response was mailed in accordance with the Certificate of Mailing requirements under 37 C.F.R. § 1.8(a).

In addition, submitted herewith is a petition under 37 C.F.R. § 1.181 to withdraw a holding of potential abandonment and the supporting documents. The Applicants note that a holding of abandonment has not been made for the above referenced matter; however, the petition would be submitted by the Applicants if such a holding were to be made.

Accordingly, enclosed please find:

- (1) a Petition to Withdraw Holding of Potential Abandonment under 37 C.F.R. § 1.181;
- (2) a copy of the Applicant's originally filed response dated September 19, 2002; and

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USSN: 10/055,794

(2) a statement under 37 C.F.R. § 1.8(b) by the undersigned attesting on a personal knowledge basis to the timely mailing of the response, which response was mailed in accordance with 37 C.F.R. § 1.8(a).

In addition, a copy of the transmittal evidencing the certificate of mailing signed by Donna Macedo and a copy of the undersigned Firm's outgoing Mail log dated September 19, 2002 are attached in support of the statement under 37 C.F.R. § 1.8(b).

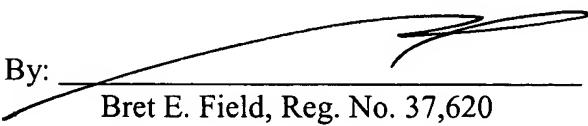
If the Examiner finds that a Telephone Conference would expedite prosecution of this application, he is invited to contact the undersigned (650) 327-3400.

The Commissioner is authorized any to charge any underpayment of fees associated with this communication to Deposit Account No. 50-0815.

Respectfully submitted,

Date: 7.8.04

By:

  
Bret E. Field, Reg. No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231



Express Mail No.: EV333997202US

<p><b>PETITION UNDER 37 C.F.R. §1.181(a)</b></p> <p><b>WITHDRAW HOLDING OF ABANDONMENT</b></p> <p>Address to:</p> <p>Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p>	Attorney Docket	CLON-069
	First Named	Farmer, Andrew Alan
	Application Number	10/055,794
	Filing Date	01-17-2002
	Group Art Unit	1636
	Examiner Name	Maria Marvich
	Title:	"SEQUENCE SPECIFIC RECOMBINASE-BASED METHODS FOR PRODUCING INTRON CONTAINING VECTORS AND COMPOSITIONS FOR USE IN PRACTICING THE SAME"

Sir:

Applicants hereby petition to withdraw a holding of abandonment of the above-referenced patent application.

The Applicants contend that the application is not in fact abandoned because a response to the outstanding Office Action was timely filed by the Applicants but was not received by the Office. Specifically, the Applicants maintain that a response to the Office Action dated July 18, 2002 was timely filed on September 19, 2002, which response was mailed to the U.S. Patent and Trademark Office in accordance with the Certificate of Mailing requirements under 37 C.F.R. § 1.8(a).

Submitted with this petition are the following:

- (1) a copy of the Applicant's originally filed response dated September 19, 2002; and
- (2) a statement under 37 C.F.R. § 1.8(b) by the undersigned attesting on a personal knowledge basis to the timely mailing of the response, which response was mailed in accordance with the Certificate of Mailing requirements under 37 C.F.R. § 1.8(a).

A fee should not be associated with such a petition; however the Commissioner is authorized to charge any associated fees with this petition, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

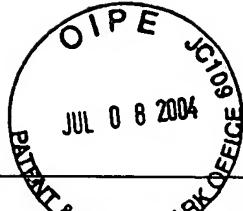
Date: 7.8.04

By: \_\_\_\_\_

  
Bret E. Field  
Registration No. 37,620

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Telephone: (650) 327-3400  
Facsimile: (650) 327-3231

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EXPRESS MAIL No.: EV333997202US

<p><b>Statement Attesting to Timely Mailing of Correspondence to U.S. Patent and Trademark Office Under 37 C.F.R. § 1.8(b)(3)</b></p> <p>Address to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p>	Attorney Docket	CLON-069
	First Named Inventor	Farmer, Andrew Alan
	Application Number	10/055,794
	Filing Date	01-17-2002
	Group Art Unit	1636
	Examiner Name	Maria Marvich
	Title:	"SEQUENCE SPECIFIC RECOMBINASE-BASED METHODS FOR PRODUCING INTRON CONTAINING VECTORS AND COMPOSITIONS FOR USE IN PRACTICING THE SAME"

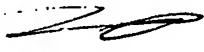
Dear Sir:

I, Bret Field attest under 37 C.F.R. § 1.8(b)(3) on a personal knowledge basis that the response to the Office Action dated July 18, 2002, was timely filed on September 19, 2002, which response was mailed to the U.S. Patent and Trademark Office in accordance with the Certificate of Mailing requirements under 37 C.F.R. § 1.8(a).

In support of this statement, submitted herewith is a copy of the transmittal evidencing the Certificate of Mailing signed by Donna Macedo on September 19, 2002 (Exhibit A) and a copy of the Firm's Outgoing Mail log for September 19, 2002 showing in the third entry that a response to an Office Action was mailed for U.S. Application Serial No. 10/055,794 (Exhibit B).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 7. 8. 04

By:   
Bret E. Field  
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231



# Exhibit A

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.			
Typed or Printed Name	Donna Macedo		
Signature	D. Macedo	Date	7/19/02

<b>AMENDMENT UNDER 37 C.F.R. §1.111</b>  Address to: Assistant Commissioner for Patents Washington, D.C. 20231	Application Number	10/055,794
	Confirmation Number	7438
	Filing Date	January 17, 2002
	First Named Inventor	Andrew Alan Farmer
	Examiner	Maria Marvich
	Group Art	1636
	Attorney Docket No.	CLON-069/ P-146

Sir:

This amendment is responsive to the Office Action dated July 18, 2002 for which a three-month period for response was given making this response due on or before October 18, 2002. In view of the amendments to the claims and the remarks put forth below, reconsideration and allowance are respectfully requested.

### AMENDMENTS

In the claims:

Cancel Claim 1.

2. (Once Amended) A sequence specific recombinase based system for use in preparing an intron containing vector, said system comprising:

a donor vector comprising at least one splice site and an acceptor vector comprising at least one splice site, wherein said donor and acceptor vectors each comprise at least one recombinase recognition site and wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein

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P-146  
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all of said recombinase recognition sites are able to recombine with each other.

7. (Once Amended) The system according to Claim 2, wherein said system further comprises a sequence specific recombinase.
8. (Once Amended) The system according to Claim 2, wherein said recombinase recognition sites are selected from the group consisting of: lox sites, att sites, dif sites and frt sites.
9. (Once Amended) The system according to Claim 2, wherein said donor and acceptor vectors are plasmids, cosmids, bac<sub>S</sub>, yacs or viruses.
10. (Once Amended) The system according to Claim 2, wherein said system further comprises a host cell.
11. (Once Amended) The system according to Claim 2, wherein each of said donor and acceptor vectors comprise a splice donor and a splice acceptor sequence.

Cancel Claims 12 to 20.

21. (Once Amended) A kit for use in producing an expression vector, said kit comprising:
  - at least one of:
    - (a) a donor vector comprising a splice site; and
    - (b) an acceptor vector comprising a splice site;
  - wherein each of said donor and acceptor vectors further comprises at least one recombinase recognition site and wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other.

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24. (Once Amended) A method of producing an intron containing vector, said method comprising:

combining a splice sequence comprising donor vector and a splice sequence comprising acceptor vector, wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other, with a recombinase under conditions sufficient for site-specific recombination to occur to produce said intron containing vector.

Cancel Claims 31 to 37.

**REMARKS UNDER 37 CFR § 1.111**

Claims 2-11 and 21-30 are pending after entry of the amendments set forth herein.

Claims 1-37 were examined and were rejected.

Claim 2 has been amended to incorporate the limits of Claim 1, and Claims 22 and 24 have correspondingly been amended. The additional amendments to the dependent claims have been made solely to bring these dependent claims into compliance with their independent claims from which they depend. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE." As the above amendments introduce no new matter to the application, their entry by the Examiner is respectfully requested.

At the top of Page 2 of the Office Action, a request was made to provide a sequence listing for the sequences shown on pages 17 and 18 of the specification.

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However, David Guzo informed the undersigned in a message dated September 17, 2002 that a sequence listing for these sequences was not in fact required under the rules. As such, the specification has not been amended to include sequence id numbers and no sequence listing is attached.

With respect to the drawings, formal drawings are being submitted herewith.

Claims 1, 7-24 and 27-37 have been rejected under 35 U.S.C. §102 (b) as lacking novelty over Griffiths. In view of the above amendments in which Claim 1 has been incorporated into Claim 2, which claim was found free of the prior art by the Examiner, as well as the amendment of Claims 21 and 24 to include the same limitation of Claim 2, this rejection may be withdrawn.

The Applicant notes that the above amendments and claim cancellations have been made solely to expedite allowance of the presence application and should not be construed as an agreement by the Applicant with the Examiner's position regarding the canceled claims and the cited prior art. The Applicant expressly reserves the right to pursue these canceled claims in a continuation application, and the Applicant still regards these canceled claims as patentable over the prior art cited by the Examiner.

**Conclusion**

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue.

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Atty Dkt. No.: CLON-069  
P-146  
USSN: 10/055,794

If the Examiner finds that a Telephone Conference would expedite prosecution of this application, he is invited to contact the undersigned (650) 327-3400.

In the event that the transmittal letter is separated from this document and the Patent Office determines that extensions or other relief is required and/or fees are due applicants, the Applicant petitions for any required relief, including extensions of time, and authorize the Commissioner to charge our Deposit Account No. 50-0815, Order Number CLON-069, for any fees due in connection with the filing of this document. The Patent Office is not authorized to charge issue fees to our Deposit Account.

Respectfully submitted,

BOZICEVIC, FIELD & FRANCIS LLP

Date: 9.18.02

By:

Bret Field  
Registration No. 37,620

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200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
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**BEST AVAILABLE COPY**Atty Dkt. No.: CLON-069  
P-146  
USSN: 10/055,794**VERSION WITH MARKINGS TO SHOW CHANGES MADE****In the claims:**

Cancel Claim 1.

2. (Once Amended) ~~The system according to Claim 1, A sequence specific recombinase based system for use in preparing an intron containing vector, said system comprising:~~

a donor vector comprising at least one splice site and an acceptor vector comprising at least one splice site, wherein said donor and acceptor vectors each comprise at least one recombinase recognition site and wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other.

7. (Once Amended) The system according to Claim 2 4, wherein said system further comprises a sequence specific recombinase.

8. (Once Amended) The system according to Claim 2 4, wherein said recombinase recognition sites are selected from the group consisting of: lox sites, att sites, dif sites and frt sites.

9. (Once Amended) The system according to Claim 2 4, wherein said donor and acceptor vectors are plasmids, cosmids, bac<sub>s</sub>, yacs or viruses.

10. (Once Amended) The system according to Claim 2 4, wherein said system further comprises a host cell.

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P-146  
USSN: 10/055,794

11. (Once Amended) The system according to Claim 24, wherein each of said donor and acceptor vectors comprise a splice donor and a splice acceptor sequence.

Cancel Claims 12 to 20.

21. (Once Amended) A kit for use in producing an expression vector, said kit comprising:

at least one of:

- (a) a donor vector comprising a splice site; and
- (b) an acceptor vector comprising a splice site;

wherein each of said donor and acceptor vectors further comprises at least one recombinase recognition site and wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other.

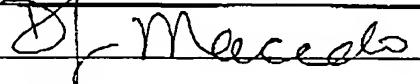
24. (Once Amended) A method of producing an intron containing vector, said method comprising:

combining a splice sequence comprising donor vector and a splice sequence comprising acceptor vector, wherein one of said donor and acceptor vectors comprises two recombinase recognition sites and the other of said donor and acceptor vectors comprises a single recombinase recognition site, wherein all of said recombinase recognition sites are able to recombine with each other, with a recombinase under conditions sufficient for site-specific recombination to occur to produce said intron containing vector.

Cancel Claims 31 to 37.

JUL 08 2004

## BEST AVAILABLE COPY

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.			
Typed or Printed Name	Donna Macedo		
Signature		Date	9/19/02

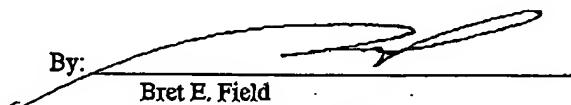
SUBMISSION OF FORMAL DRAWINGS		Customer Number	24353
Address to: Commissioner for Patents Washington, D.C. 20231	Application Number	10/055,794	
	Confirmation Number	7438	
	Filing Date	January 17, 2002	
	First Named Inventor	FARMER, ANDREW ALAN	
	Examiner Name	MARVICH, MARIA B.	
	Group Art Unit	1636	
	Attorney Docket	CLON-069	

Sir:

Transmitted herewith are 5 sheets of formal drawings to be filed in connection with the above-identified application.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number CLON-069.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: 9.19.02By: 

Bret E. Field  
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, California 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231

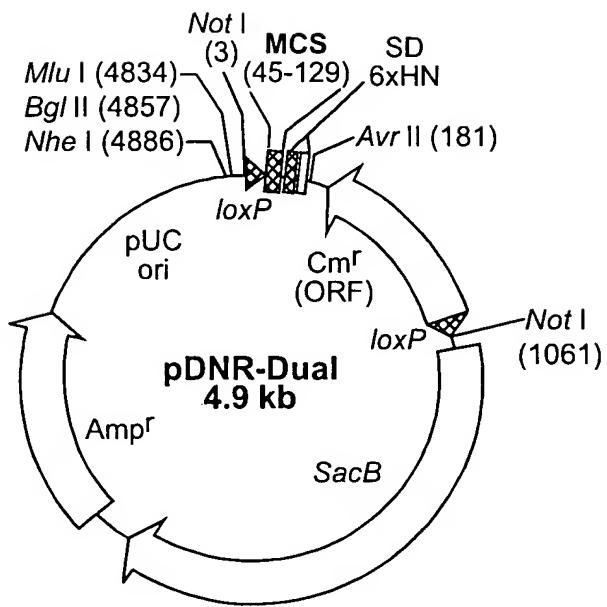


FIG. 1

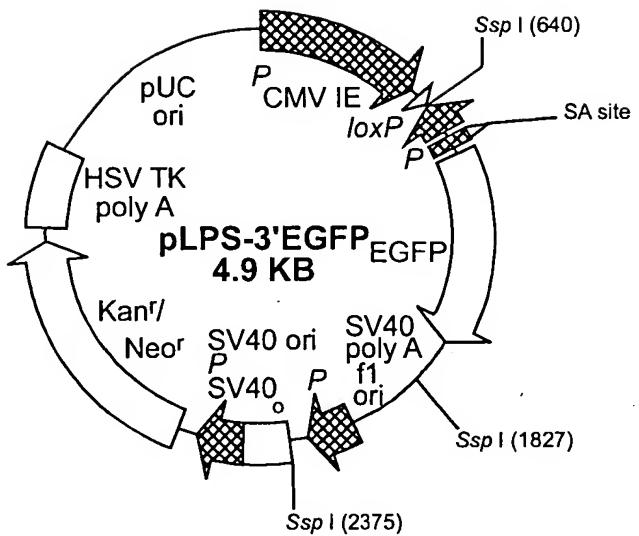


FIG. 2

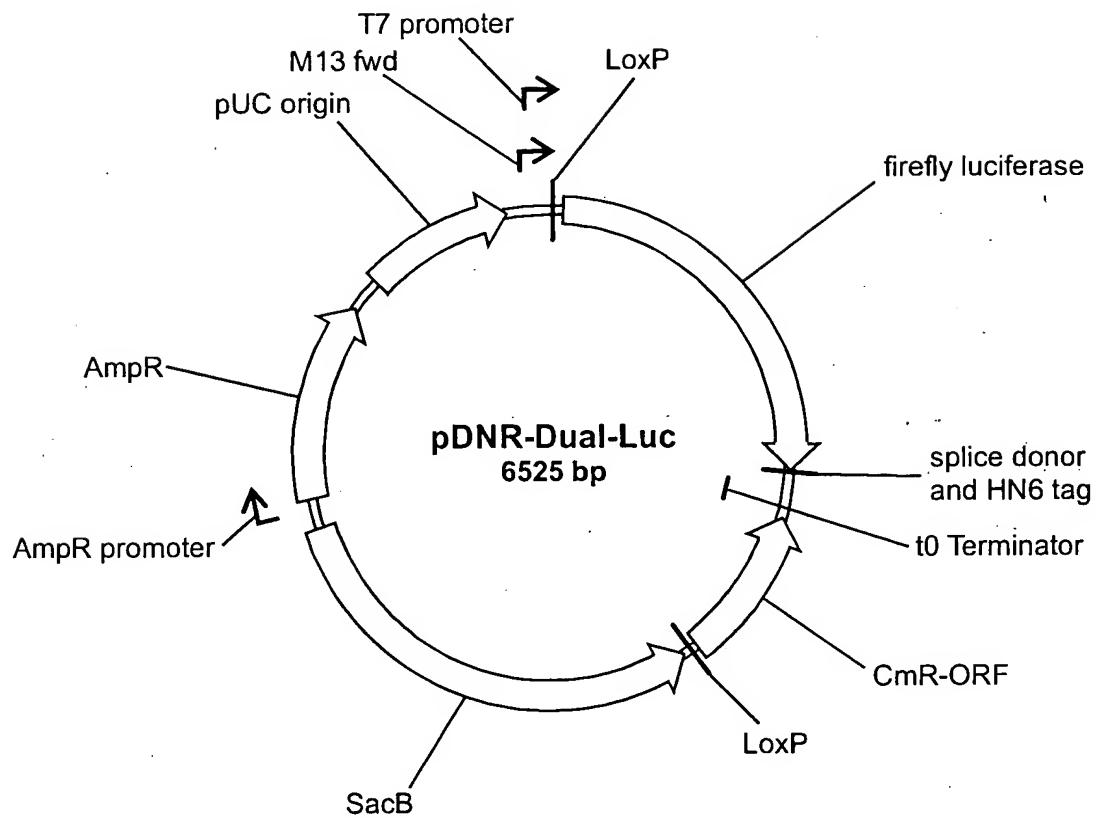
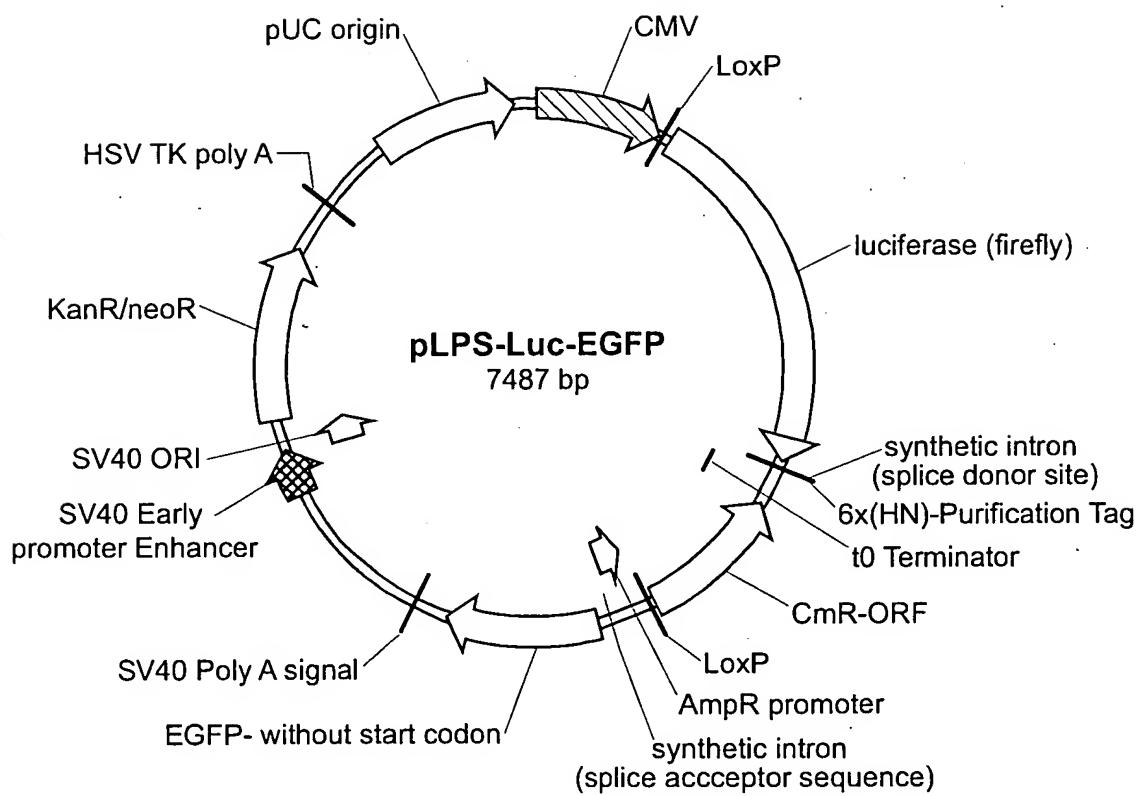


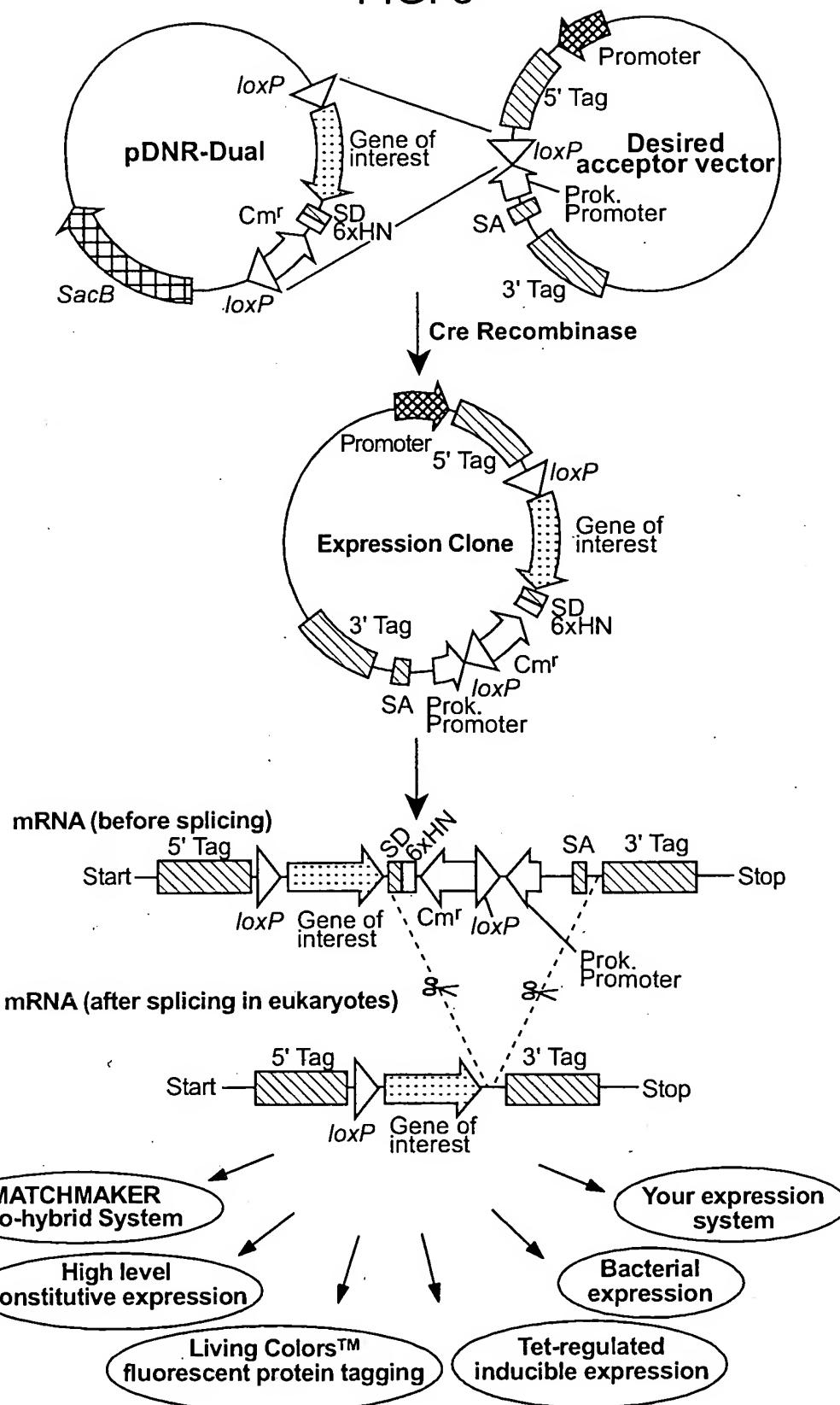
FIG. 3



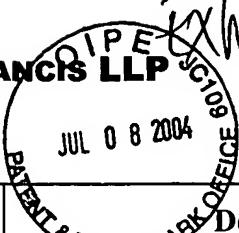
**FIG. 4**



FIG. 5



SEPTEMBER 19, 2002



Atty. Docket No.	Serial Number	Description	Atty.	Fee	Billing Code
YAMA-007	09/543,449	Fee Address Indication	BEF		
BERK-001CON2	08/966,398	Fee Address Indication	BEF		
CLON-069	10/055,794	Transmittal, Amendment, Formal Drawings Transmittal, 5 Sheets of Figures	BEF		D28, D61
+UCAL-105CIP2	10/040,315	Fax Cover, Request for Corrected Notice of Recordation, Copy of Incorrect Notice	BEF		D71
+BERK-017	10/136,860	Fax Cover, Request for Corrected Notice of Recordation, Copy of Incorrect Notice	BEF		D71
UCSF-129	09/535,145	Transmittal, Amendment After Final Rejection, Appendices A-C	JSK		D64
+UCAL-263CON	09/920,085	Fax Cover, Transmittal, Restriction Election	PAB		D57
+STAN-110CON	09/837,446	Fax Cover, Transmittal, Fee Transmittal <i>in duplicate</i> , Preliminary Amendment/Response to Restriction Requirement, Petition for a 4 Month Extension of Time	JSK	\$720	D57
CLON-033CIPCON	10/117,825	IDS, SB08A, 1 Cited Reference	BEF		D22
LIFE-069	09/784,993	Transmittal, PTOL-85B <i>in duplicate</i> , Associate Power of Attorney	CML	\$1610	D23
*TOSK-007WO		Transmittal of Express Mail, PCT Request, Fee Sheet, (2) PCT POA's, Specification, Claims, Abstract, 7 Sheets of Figures, (1) PCT EZ Diskette Express Mail No. EV012444324US	BEF	\$1,499	D54
AERX-091		Utility Patent Application Transmittal, ADS, specification, Claims, Abstract, 4 Sheets of Figures Express Mail No. EL779661497US	FPB		D21
+DURE-007	09/522,535	Fax Cover, Transmittal, Amendment After Final	CLF		N/A

+ Indicates after hours filing.

\* Indicates error(s) within original filing.

**DATE: July 8, 2004**



**EV333997202US**

**THE EXPRESS MAIL NUMBER OF THE DAY IS: EV333997202US**

**The person taking the Express Mail to the Post Office is: Stuart McLeish**

**EXPRESS MAIL CERTIFICATION**

Date of Deposit: **07/08/2004** I hereby certify that the below-listed papers or fees were inserted into a package addressed to: Commissioner for Patents, PO BOX 1450, Alexandria, Virginia 22313-1450 and was deposited by me with the United States Postal Service "Express Mail Post Office Addressee" service under 37 C.F.R. § 1.10 on the date indicated above.

Signature

Date

**7/8/04**

Atty. Docket No.	Serial Number	Description	Atty.	Fee
DAFU-001DES	29/175,219	Request to Withdraw as Attorney of Record	CML	
AGYT-011CIP2	10/090,698	Transmittal, Fee Transmittal <i>in duplicate</i> , Amendment, Terminal Disclaimer, Supplemental ADS	PJS	\$55
AERX-096CON	09/220,421	Petition for a 3 Month Extension of Time <i>in duplicate</i>	CML	\$950
LIFE-077	10/116,386	Transmittal, Amendment	SCT	
CORA-011	09/648,282	Transmittal, Communication, Petition under 1.181(a), Copy of Response as Filed 12/19/03, Statement Attesting Timely Mailing of Correspondence under 37 CFR 1.10(e), Copy of Return Postcard Never Rcvd, Copy of Express Mail Label No. EV333998300US W/receipt of Entry, Copy of Track & Confirm, Copy of Outgoing Mail Log dated 12/19/03	BEF	
INTM-008	10/490,458	Transmittal, IDS, SB08A, Copies of (20) Cited References	PAB	
UCAL-296	10/799,854	Transmittal, IDS, SB08A, Copies of (13) Cited References	PAB	
DOSH-002	10/627,583	Transmittal, IDS, SB08A, Copy of Intl Search dated 07/06/04	BEF	
CLON-069	10/055,794	Transmittal, Communication, Petition under 1.181(a), Copy of Submission filed 09/19/02, Statement Attesting Timely Mailing of Correspondence 1.8(b)(3), Exhibits A-B	BEF	